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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,776	10/23/2000	Joseph Sforzo		8512
7590	04/03/2006		EXAMINER	
Thomas A. O'Rourke Wyatt, Gerber & O'Rourke 99 Park Avenue New York, NY 10016			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/694,776	SFORZO, JOSEPH
	Examiner	Art Unit
	JAGDISH PATEL	3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 January 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-17,20-35,38-42 and 44-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2-17,20-35,38-42 and 44-47 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. This communication is in response to amendment filed 1/19/2006.

Response to Amendment

2. Claims 38-42, 46 and 47 have been amended. Claims 2-17, 20-35, 38-42 and 44-47 are currently pending. The amendment has overcome 35 U.S.C. §101 (lack of technological implementation) issues raised in the prior office action. (Note that the technological art is no longer a valid requirement under 35 U.S.C. §101 in view of the recent Ex parte Lundgren decision, 76 USPQ2d 1385 (Bd. Pat. App. & Int. 2005)).

Response to Arguments

3. Applicant has not provided any arguments or remarks concerning the claim analysis provided in the prior office action, in particular any explanation how the amended claims have overcome the claims rejection under various provisions of 35USC 112 (second). In this regard the applicant is not fully responsive to the prior office action.

The amendment has not fully resolved the deficiencies previously identified under 35 USC 112(second) as further explained below.

Claim Rejections - 35 USC § 112

4. Claims 2-17, 20-35 and 38-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4.1 General (All claims): the amended claims recites in the preamble that the method of obtaining a surety is carried out over a computer network which comprises, an agent computer, a surety computer and a third party computer. However, the claim limitations do not suggest use of the respective computers in carrying out the process steps in association with the recited parties (e.g. the agent, the surety, and the third party). In order to resolve this defects the claims must specify role of each computer in the network in carrying out a respective process step in conjunction with the associated party.

5. 4.2 Lack of antecedent Basis (Where applicable)

The claims refers to “a computer network”, (claim 38 preamble, claim limitation a)) and “said computer network” (claim 38 preamble, claim limitations b)-e) etc.). This renders the claim indefinite because the limitation “a computer network” and “said computer network” cannot be properly correlated.

Claim 46: “said bonding agency” lacks proper antecedent basis.

6. Claim 46 further recites that an applicant accesses a website of a bonding agent. However, the website of the bonding agent is recites as being located on the computer network. Likewise the claim recites that the bonding agent selects a surety over said computer network, whereas there is no relationship of the bonding agent to the computer network.

Similar deficiency is also present in claim 47.

7. Claim 40, additionally contains the following deficiencies.

Line 3 of claim recites “proving a computer network with identity of an applicant ..said surety”. This limitation renders the claim indefinite because the providing the computer network with the identity is unclear. A computer network is a conduit of transmitting information and not a computing device or a physical entity to whom information (i.e. the identity of an applicant) can be provided.

The limitation “selecting surety” is unclear because there is no basis for selecting a surety. The providing step provides an identity of an applicant to a surety. The selection of a surety is independent of the surety who requests identity of the applicant, there is no process step responsive to the providing step, which plays any role in selection of a surety.

Claims 46 and 47 also contain deficiencies similar to those identified for other method claims.

8. Claim 42 is not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble the claim refers to a system, but the body of the claim recites the specifics of the system (means for) and the process (steps f) and g).

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claim 42 is rejected under 35 U.S.C. §101 because the claimed invention is directed to a non-statutory subject matter.

Claim 42: 35 U.S.C. §101 requires that in order to be patentable the invention must be a “new and useful process, machine, manufacture or composition of matter or new and useful improvement thereof” (emphasis added). Applicant’s claim mentioned above is intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101. The claim begins by discussing a system (ex. Preamble of claim 41), the body of the claim recites the specifics of the system and method (limitations a)-e) are limitations of a system and limitations f)-g) are limitations of a process). (see rejection of claims under 35 U.S.C. §112, second paragraph, for specific details regarding this issue). “a claim of this type is precluded by express language of 35 U.S.C. §101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only”, Ex parte Lyell (17USPQ2d 1548).

11. Claims 41 and 42 are rejected under 35 USC § 101 because the claimed inventions are directed to non-statutory subject matter. Claims 41 and 42 are directed to disembodied data structure which are *per se* are not statutory (*In re Warmerdam*, No. 93-1294 (Fed. Cir. August 11, 1994)).

Note that functional descriptive material consists of data structure and computer programs, which impart functionality when employed as a computer component. Nonfunctional descriptive material includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Quoting MPEP section 2106. IV. B. 1.

“When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk.”

The “means for” elements of the system claims are interpreted as computer codes that perform the associated functions when executed by a computer processor such data structures themselves are passive and cannot perform any function. Only when the Data structures are used or accessed in conjunction with programmed computer instructions codes to realize the underlying functionality. In the instant case, the data structure is mere arrangement of data (means) that are intended to perform various functions. The subject claims when broadly interpreted computer software programs or executable codes which are not functionally or structurally interrelated and not executed by a processor to realize any functionality. Therefore, the claims are interpreted as functional descriptive material which are not capable of producing useful, concrete and tangible result, i.e. non-statutory under 35 USC 101.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

3/26/06